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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/541,554

08/18/2005

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EXAMINER

JACKSON, BRANDON LEE

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

06/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/541,554 | Applicant(s) SAILHEN, PASCAL | |
| | Examiner Brandon Jackson | Art Unit 3772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/06/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/06/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 11. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because of legal phraseology.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Grim et al. (US Patent 5,348,530). Grim discloses an inflatable ankle brace (16), comprising two lateral shells (18, 20), two inflatable bags (22, 24) in the upper halves of the shells (18, 20), a means for inflation (26, 84, 86), and straps (34, 36) for connecting the two shells (18, 20) to the left and right sides of the ankle (fig. 7). The inflation means (26, 84, 86) are made of a flexible material (col. 4, lines 64-68). The lower halves of the shells (18, 20) have foam cushioning members (89) on the interior next to the ankle.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim et al. (US Patent 5,348,530) in view of Alber (US Patent 2,884,646). Grim substantially discloses the claimed invention; see claim 1 rejection above. Grim fails to disclose one common valve in the front of the brace in the front of the brace, flexible continuously formed inflations and conduit walls, and a continuous tongue. However, Alber teaches an ankle bladder (10) comprising a valve (14, 16) with bridging conduit (13) for connecting bladders (11, 12). The walls of the bridging conduit (13) are flexible and are continuously formed with the walls of the bladder (11, 12). The bridging conduit (13) would also function as a tongue that would be under the straps when the straps are tightened. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Grim invention with the bridging conduit and single valve, as taught by Alber, in order to allow the user to simultaneously inflate or deflate both bladders at the same rate.

The valve in the front portion of the brace provides no advantage, is not used for a particular purpose, and does not solve a stated problem. The Grim/Alber device would function equally as well with a valve in the front of the brace instead of the rear. Therefore, it is a mere design choice and would be obvious to one of ordinary skill in the art at the time of the invention to modify the Grim/Alber device to have the valve and bridging conduit in the front of the brace.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim et al. (US Patent 5,348,530). Grim substantially discloses the claimed invention; see claim 1 rejection above. Grim fails to disclose points and/or lines of connection between the opposite walls comprising parallel weld seams in the upper half of the inflatable bags. However, Grim discloses weld lines (col. 2, lines 60-66) in the brace (16). However, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Grim device with parallel weld lines in the inflatable bags in the upper halves of the shells in order to control the flow of the air through the brace.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grim/Alber as applied to claims 1-2 above, and further in view of Johnson, Jr. (US Patent 4,628,945). Grim/Alber fails to disclose an auxiliary bag open in its upper part to hold a cushion. However, Johnson teaches a inflatable ankle brace with back (28a) which opens at the top (fig. 1) to receive a cushion (48a). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Grim/Alber device with the cushion bag, as taught by Johnson, in order to allow the preferable cushion to be placed in the brace.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson, Jr. et al. (US Patent 5,314,455), Potter (US Patent 5,765,298), Iglesias et al. (US Patent 5,716,335), Grim et al. (US Patent 5,445,602), Johnson, Jr (US Patent 5,125,400), Johnson, Jr. (US Patent 5,389,065), Sroufe et al. (US Patent 6,554,785), Iglesias et al. (US Patent 5,951,504), Alber (US Patent 2,774,152).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Jackson whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brandon Jackson
Examiner
Art Unit 3772

BLJ


PATRICIA BIANCO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

6/11/07